

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ieyasu Kobayashi, et al.

Confirmation No.: 8235

Application No.: 09/914,033

Art Unit: 3654

Filed: August 22, 2001

Examiner: W. Rivera

For: POLYESTER FILM ROLL

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Reply Brief under 37 C.F.R. §41.41 in response to the Examiner's Answer mailed on March 24, 2005.

All arguments presented within the Appeal Brief of January 10, 2005 are incorporated herein by reference. Additional arguments are provided herein below.

In the Examiner's Answer, the Examiner argued that the film roll of Sasaki et al. being "*free from wrinkles*" means that the difference between the maximum and minimum diameters of such a roll *equal zero*. However, Applicants respectfully disagrees with the Examiner's arguments in this regard.

Sasaki et al. teach the elimination of wrinkles which appear during winding of a smooth film into a film roll, by means of "*hard*" winding (see columns 3 and 4 of Sasaki et al.). By hard winding, wrinkles may be eliminated. However, slacks based on uneven thickness of a film cannot be prevented by hard winding. If a film is wound tightly to control the "hardness" of the film roll, slacks will increase due to the uneven thickness of the film itself. Thus, even if there are no wrinkles on a rolled film, it cannot be concluded that there is no unevenness in thickness of the film which would cause differences in the maximum and minimum diameters of the film roll

Under U.S. case law, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). In relying upon the theory of inherency, the Examiner ***must provide a basis in fact and/or technical reasoning*** to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. In other words, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not, as applicable in this case, be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

In this case, the Examiner has not provided any basis in fact and/or technical reasoning to reasonably support the determination that the claimed limitations necessarily flows from the teachings of Sasaki et al. The Examiner notes the teaching of "wrinkle free" film roll in Sasaki et al.'s disclosure but does not explain its relationship with the maximum and minimum diameters of the polyester film roll. The Examiner only concludes that Sasaki's invention being "wrinkle free" accounts for all the unevenness of the film. However, as explained above, elimination of wrinkles by hard winding does not prevent (1) formation of slacks due to uneven thickness of the film and (2) differences in the maximum and minimum diameters of a film roll.

It is important to note that Sasaki et al. does not teach that its film have the same thickness throughout the width and length of its film. Instead, Sasaki et al. only requires that its film have a thickness not greater than 25 microns and an "average" surface roughness of from 0.001 to 0.05 microns. Such statements clearly indicate that the thickness of the film in Sasaki et al. is uneven. Hence, even though a film is tightly wound using pressure of a touch roll as disclosed by Sasaki et al, Sasaki et al cannot prevent uneven thickness of a film roll. Thus, the difference between the maximum and minimum diameters of the film roll in Sasaki et al. does not ***equal zero***.

Thus, for these reasons, the Examiner has not provided any basis in fact and/or technical reasoning that the film roll of Sasaki et al. would meet the recitations of the claims.

It is further noted that Sasaki et al. does not disclose taking measurements of the film roll to minimize the difference between the maximum and minimum thickness of the film roll by making adjustments to the rolling process. The comparative example in the specification shows

that slacks are formed when adjustments to the rolling process are not made. Since Sasaki et al. does not teach making any adjustments to its rolling process, it can not be concluded by inherency that the difference between the maximum and minimum diameters of the film roll in Sasaki et al. *equals zero* or meet the requirements of the claims.

Unlike Sasaki et al., the film roll of the present invention have specific dimensions as defined by the claims which prevents both wrinkles and slacks, and are obtained using highly accurate uneven thickness information which flattens the roll shape and lessens as much as possible the uneven thickness of the film roll (see page 4, second paragraph and page 8, fifth paragraph, of the specification). Thus, it is clear that the limitations of the present claims are not taught or suggested, either literally or inherently, Sasaki et al.

Applicant also wishes to note that contrary to the Examiner's arguments, the limitation "*wherein the first maximum perpendicular line length is not more than 500 μm , and the second maximum perpendicular line length is not more than 300 μm* " cannot be interpreted as a process limitation since **it relates directly the dimensions of the film roll**. In other words, since the limitation relates to the shape and structure of the film roll, the Examiner must give this limitation patentable weight as required under U.S. practice.

CONCLUSION

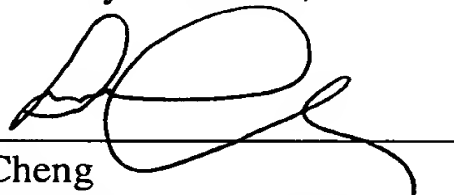
For at least the reasons set forth hereinabove, the rejection(s) of the claimed invention should not be sustained.

Therefore, a reversal of the Final Rejection of August 10, 2004 is respectfully requested.

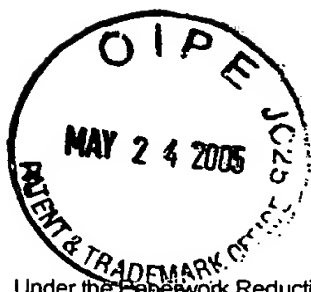
If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: May 24, 2005

Respectfully submitted,

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	Examiner Name	W. A. Rivera
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ENCLOSURES (Check all that apply)		
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
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Signature			
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Date	May 24, 2005	Reg. No.	40,949